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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. GEORGE and MALGORZATA E. STYS

Appeal 2009-007749
Application 10/728,864
Technology Center 2400

Before JOHN A. JEFFERY, JAY P. LUCAS, and JAMES R. HUGHES,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants invented a method, apparatus, medium, and system for capturing user interactions and feedback. *See generally* Spec. 1, 5. Claim 1 is illustrative:

1. A method of enhancing a dialog with a web server, said method comprising:
determining a dialog state by comprehensively capturing a dialog with said web server.

The Examiner relies on the following as evidence of unpatentability:

Jawahar	US 6,298,356 B1	Oct. 2, 2001
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THE REJECTION

The Examiner rejected claims 1-30 under 35 U.S.C. § 102(b) as anticipated by Jawahar. Ans. 3-11.^{2,3}

CLAIM GROUPING

Appellants argue the following claim groupings separately: (1) claims 1, 2, 8-10, 12, 14-17, 19-24, and 27-29⁴; (2) claims 3 and 4; (3) claim 5; (4) claims 6 and 7; (5) claims 11, 13, and 18; (6) claims 25 and 26; and (7) claim 30. *See* App. Br. 13-16. Accordingly, we select claims 1, 3, 6, 11, and 25 as representative of groups (1), (2), and (4)-(6). *See* 37 C.F.R. § 41.37(c)(1)(vii).

² Throughout this opinion, we refer to (1) the Appeal Brief filed July 29, 2008; (2) the Examiner's Answer mailed October 20, 2008; and (3) the Reply Brief filed December 22, 2008.

³ The § 101 rejection of claims 14-23 has been withdrawn. Ans. 11.

⁴ Claims 2, 8-10, 12, 14-17, 19-24, and 27-29 were not separately argued. *See* App. Br. 13-16.

THE CONTENTIONS

Regarding representative claims 1 and 30, the Examiner finds that Jawahar discloses determining a dialog state by comprehensively capturing a dialog with the web server by monitoring a user's access to information contained in a web server. Ans. 3, 10. Appellants argue that Jawahar does not use an intermediary and does not comprehensively capture the whole dialog, including all requests and responses being redirected through the intermediary. App. Br. 13-15; Reply Br. 1-2.

As for representative claim 3, the Examiner finds that Jawahar discloses analyzing the dialog content. Ans. 3. Appellants argue that Jawahar's disclosure of monitoring time spent on an accessed web page does not reasonably satisfy the plain meaning of claim 3. App. Br. 15.

Regarding claim 5, the Examiner finds that Jawahar discloses the analyzing step optionally comprise natural language processing. Ans. 4. Appellants contend that Jawahar fails to disclose a natural language processing capability. App. Br. 15.

As for representative claim 6, the Examiner finds that Jawahar discloses an intermediary. Ans. 4, 9. Appellants contend that Jawahar fails to disclose using an intermediary as defined and understood by an ordinarily skilled artisan. App. Br. 15.

Regarding representative claim 11, the Examiner refers to the discussion of claim 10. Ans. 5-6. Appellants assert that Jawahar fails to disclose the user's dialog with the original server will continue if the user moves to another unrelated server. App. Br. 15; Reply Br. 1-2.

Regarding representative claim 25, the Examiner finds that Jawahar discloses the recited means by referring to the discussion of claims 6 and 7. Ans. 9, 5. Appellants contend that Jawahar fails to teach or suggest the means described in the application or an equivalent. App. Br. 15-16.

The issues before us, then, are as follows:

ISSUES

Under § 102, has the Examiner erred by finding that Jawahar discloses:

- (1) determining a dialog state by comprehensively capturing a dialog with a web server as recited in claim 1?
- (2) the determining step includes analyzing the dialog's content as recited in claim 3?
- (3) the analyzing step optionally comprises natural language processing as recited in claim 5?
- (4) an intermediary as recited in claims 6 and 30?
- (5) the dialog continues to be captured when a second web server is selected by the user as recited in claim 11?
- (6) the recited means in claim 25?
- (7) comprehensively capturing a dialog with a web server as recited in claim 30?

FINDINGS OF FACT

1. Appellants have not defined the terms, “dialog state” and “comprehensively capturing.” *See generally* Specification.
2. Jawahar discloses monitoring an individual’s access to information contained in a web server. Jawahar, col. 3, ll. 52-54.
3. Jawahar monitors: (a) all web page accesses, including a web browser’s “back” and “forward” functions; (b) whether a user selects a “Help” button (e.g., step 236); (c) whether the user has accessed a different web page (e.g., step 240); and (d) the total time a user views a web page at step 252. Jawahar, col. 14, ll. 40-49; col. 15, l. 60 – col. 16, l. 22; col. 16, ll. 48-50; Figs. 7A-B.
4. Jawahar describes a procedure used to determine whether to display a “Help” button to a user by examining the content of the viewed web page (e.g., product or service displayed or discussed in web page). Jawahar discloses monitoring the time a user spends on a single or various web pages on a web server at steps 250 and 252, and may display a “Help” button after a predetermined time of viewing web pages at steps 260 and 262 or a predetermined number of web pages at steps 264 and 262. Jawahar, col. 3, ll. 59-61; col. 13, l. 65 – col. 14, l. 12; col. 14, ll. 62-67; col. 16, ll. 40-67; col. 17, ll. 24-33; Fig. 8.

PRINCIPLES OF LAW

“The difference in meaning and scope between claims is presumed to be significant to the extent that the absence of such difference in meaning and scope would make a claim superfluous.” *Free Motion Fitness, Inc. v. Cybex Int’l, Inc.*, 423 F.3d 1343, 1351 (Fed. Cir. 2005) (citations omitted).

Claims 1, 13, and 18

ANALYSIS

We begin by construing the key disputed and only limitation of claim 1 which calls for, in pertinent part, determining a dialog state by comprehensively capturing a dialog with a web server. As a preliminary matter, claim 1 fails to recite an intermediary. That is, unlike dependent claim 6 which claims an intermediary, claim 1 is broader in scope. *See Free Motion*, 423 F.3d at 1351. We therefore find that Appellants' arguments related to an intermediary and redirection (App. Br. 13-14; Reply Br. 1-2) are not commensurate with the scope of claim 1.

Additionally, contrary to Appellants' discussion (App. Br. 13), the Specification does not define the terms, "dialog state" or "comprehensively capturing." FF 1. Moreover, Appellants provide no evidence that the phrases, "dialog state" or "comprehensively capturing," have a particular meaning to those skilled in the art. *See* App. Br. 13-14; Reply Br. 1-2. We therefore attach no particular meaning to word "comprehensively," such that claim 1 requires the whole dialog or all user requests and server responses must be captured. Rather, claim 1 recites capturing only "a dialog." Also, the phrase, "a dialog state" will be given its broadest reasonable construction to include a condition of the dialog, such as how long the dialog lasts. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (internal citations omitted).

Jawahar discloses monitoring or capturing an individual's access to information contained in a web server. FF 2. As Appellants admit (App. Br. 15), Jawahar specifically discloses tracking the time a user spends on

various web pages on a web server or capturing the length of the user's dialog. *See* FF 3. Jawahar further discloses capturing other interactions, including: (a) a browser's "back" and "forward" functions (*id.*); (b) whether the user has accessed a different web page (*see id.*); and (c) whether a user selects a "Help" button (*see* FF 3-4). Additionally, Jawahar examines the content of a web page to determine whether to display a "Help" button. *See* FF 4. All these captured interactions are dialogs with a web server. By capturing these activities, Jawahar further determines a condition of these interactions, including whether a website is being accessed, the time length that a web site is being accessed, whether user is requesting help, and whether the user is requesting a different web page. *See* FF 3-4. We therefore find that Jawahar discloses determining a dialog state by comprehensively capturing a dialog with the web server as recited in claim 1.

For the foregoing reasons, Appellants have not shown error in the anticipation rejection of independent claim 1 based on Jawahar. We therefore sustain the rejection of claim 1, and claims 2, 8-10, 12, 14-17, 19-24, and 27-30, which fall with claim 1.

Claims 3 and 4

ANALYSIS

Based on the record before us, we find no error in the Examiner's anticipation rejection of representative claim 3 which calls for, in pertinent part, analyzing the dialog's content. As discussed above, Jawahar discloses several scenarios of determining a dialog state involving analyzing the content of the dialog. *See* FF 3-4. For example, Jawahar discloses

determining whether to display a “Help” button by analyzing the content of each web page viewed or analyzing whether the user selects a “Help” button. *See id.* We therefore disagree with Appellants that Jawahar fails to teach the step of determining a dialog state further comprises analyzing a dialog’s content as required by claim 3.

For the foregoing reasons, Appellants have not shown error in the anticipation rejection of claim 3 based on Jawahar. We therefore sustain the rejection of claim 3, and claim 4 which falls with claim 3.

Claim 5 ANALYSIS

We begin by construing the key disputed limitation of claim 5 which calls for, in pertinent part, the analyzing step optionally comprises natural language processing. By reciting the analyzing step *optionally* comprises natural language processing, this natural language processing step fails to limit the claim. Rather, the processing step is just an option. We therefore find that Jawahar discloses the limitations of claim 5, even if the reference fails to teach natural language processing capability as Appellants contend (App. Br. 15).

For the foregoing reasons, Appellants have not shown error in the anticipation rejection of claim 5, and we therefore sustain the rejection of claim 5.

Claims 6 and 7

FINDINGS OF FACT

5. Appellants define “intermediaries” as “computational entities . . . that can be positioned anywhere along an information stream and are programmed to tailor, customize, personalize, or otherwise enhance data as it flows along the stream.” Spec. 12:19-13:2.

6. Jawahar discloses a transaction processing system 10 coupled to server 12, a local area network (LAN) 16, and a public switched telephone network (PSTN) 14 and receives transactions from server 12. This processing system 10 receives, transmits, queues, routes and processes transactions. Jawahar, col. 4, ll. 17-19, 27-51; Fig. 1.

7. Jawahar teaches the customer (e.g., 22, 24) can interact with an agent (e.g., 20) through the transactional processing system 10. Data regarding web pages viewed by the user while communicating with an agent selected to provide help can be collected. Jawahar, col. 5, l. 47 – col. 6, l. 61; col. 15, l. 64 – col. 16, l. 6.

8. Jawahar teaches that the access monitoring application and the accompanying JavaScript and Java applets may or may not be downloaded to the user computer. Jawahar, col. 14, ll. 13-19, 38-39; Fig. 7A.

ANALYSIS

Based on the record before us, we find no error in the Examiner’s anticipation rejection of representative claim 6 which calls for, in pertinent part, the comprehensively capturing step comprises directing information to an intermediary. Appellants define an intermediary as a computational entity “that can be positioned anywhere along an information stream and [is]

programmed to tailor, customize, personalize, or otherwise enhance data as it flows along the stream.” *See* FF 5. Jawahar discloses a transaction processing system 10 that is positioned along an information stream between a user (e.g., 22), a server (e.g., 12), and an agent (e.g., 20). *See* FF 6-7. This processing system 10 is also used to queue and route transactions between the user and agent and is thus programmed to tailor or enhance data as its flows along the stream. *See id.* Moreover, data related to the web pages accessed by the user can still be captured during these interactions between user and agent. *See* FF 8. Jawahar’s processing system 10 is therefore an intermediary (i.e., a computational entity that is positioned along the information stream and is programmed to tailor or enhance data as its flows along the stream) as defined.

Appellants also argue that Jawahar does not disclose an intermediary because the Java components are downloaded to a user browser. App. Br. 15. This argument is not commensurate in scope with claim 6, which fails to limit where the dialog capturing occurs. That is, there is no requirement that the capturing occurs at the intermediary – only that capturing causes requests and responses to be directed to the intermediary. Jawahar discloses such an embodiment in Figure 1 where monitored traffic flows between a user (e.g., 22) and an agent (e.g., 20) through server 12 and intermediary 10. *See* FF 6-7. Moreover, Jawahar teaches an embodiment where the access monitoring application is not downloaded to the user computer. *See* FF 8.

For the foregoing reasons, Appellants have not shown error in the anticipation rejection of claim 6 based on Jawahar. We therefore sustain the rejection of claim 6, and claim 7 which fall with claim 6.

Claims 11, 13, and 18

FINDINGS OF FACT

9. Jawahar discloses that the procedures in Figures 7A-B can be executed on multiple or different web servers. One procedure may terminate when a user accesses a different web server, and a new procedure may be initiated on a new web server. Jawahar, col. 16, ll. 11-27; Figs. 7A-B.

ANALYSIS

Based on the record before us, we find no error in the Examiner's anticipation rejection of representative claim 11 which calls for, in pertinent part, the dialog continues to be captured when a second server is selected by the user and requests are sent to the new server. Jawahar discloses that procedures in Figures 7A-B, which includes capturing dialog information (e.g., whether a user selects a "Help" button and how long a web page or pages are viewed (*see* FF 3-4)), can also be performed when the user accesses a different web server. *See* FF 9. Jawahar therefore discloses a dialog can continue to be captured when a second web server is accessed or selected by the user and requests are sent to the new server as recited in claim 11. For the foregoing reasons, Appellants have not shown error in the anticipation rejection of claim 11 based on Jawahar. We therefore sustain the rejection of claim 11 and claim 13 and 18, which fall with claim 11.

Claims 25 and 26

ANALYSIS

Based on the record before us, we find no error in the Examiner's anticipation rejection of representative claim 25 which calls for, in pertinent

part, a means for receiving an initial access request to the web server and a means for comprehensively capturing a dialog between the browser and the web server based on the request. The Examiner has satisfied the initial burden to set forth the basis for anticipated claim 25's means for receiving a request and capturing a dialog between the browser and the server as recited. *See* Ans. 9, 4. Appellants, on the other hand, have not provided any evidence to demonstrate that the Examiner erred in these findings. *See* App. Br. 15-16. Thus, weighing the evidence before us, we find in favor of the Examiner. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). Also, arguments made by counsel do not take the place of evidence in the record. *In re Geisler*, 116 F.3d 1465 (Fed. Cir. 1997).

For the foregoing reasons, Appellants have not shown error in the anticipation rejection of independent claim 25 based on Jawahar. We therefore sustain the rejection of claim 25, and claim 26 which fall with claim 25.

Claim 30

ANALYSIS

Based on the record before us, we find no error in the Examiner's anticipation rejection of claim 30 which calls for, in pertinent part, comprehensively capturing the dialog with the server by setting up an intermediary. As discussed above for claim 6, Jawahar discloses an intermediary. *See also* FF 6-7. Additionally, claim 30 does not recite a dialog state and thus any arguments related to a dialog state are not commensurate in scope with claim 30. We also refer to our discussion for

claims 1 and 6 for any remaining arguments, including whether Jawahar teaches downloading the access monitoring application to the user's computer (App. Br. 13).

Finally, Appellants assert for the first time in the Reply Brief that Jawahar does not disclose directing subsequent dialog to an intermediary by adding the intermediary's URL to all inbound and outbound portions of the dialog. *See* Reply Br. 1-2. This argument is untimely and is therefore waived. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

We therefore sustain the rejection of independent claim 30.

CONCLUSION

The Examiner did not err in rejecting claims 1-30 under § 102.

ORDER

The Examiner's decision rejecting claims 1-30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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